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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,539	03/29/2001	Kazutoyo Machiro	6514-5	4166

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GREENBLUM & BERNSTEIN, P.L.C.
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EXAMINER

MCCULLOCH JR, WILLIAM H

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	12/28/2006	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/28/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary

Application No.

09/820,539

Applicant(s)

MAEHIRO, KAZUTOYO

Examiner

William H. McCulloch Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments received 7/29/2006. Claims 1-6 are pending in the application, with claim 6 withdrawn and claims 2, 3, and 5 currently amended.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the utilization status" in lines 2-3, 4, and 6. There is insufficient antecedent basis for this limitation in the claim. Claim 2 recites "a utilization state". For the purposes of this examination, claim 2 will be interpreted as reciting "a utilization status" instead of the present recitation of "a utilization state". Such interpretation is based upon the fact that amended claim 3 was altered from the previous recitation of "state" to recite "status". Appropriate correction is required.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites a recording medium containing a program executed by a server system. The claim further recites that the server system includes a profile server and an information providing server. Therefore, it is unclear as to which

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of the profile server and/or the information providing server is actually executing the program. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 5,793,365 to Tang et al. (hereinafter Tang).

Regarding claim 1, Tang describes the following features:

- a) A server system connected to a group of game machines via a communications network (see at least abstract and fig. 10);
- b) A profile server and an information providing server (see at least fig. 10 and 11:5-57). The profile server corresponds to the directory service 129 and the information providing server corresponds to the database 131;
- c) A registration system that selects and records at least one second user in said profile server to allow a first user to check personal information about the second user (see at least abstract, 5:43-6:10, 7:56-61, and 9:6-21);
- d) A notifying system that causes, when a game machine of the at least one second user sends a request for an information service, said information providing server to notify said profile server of the request (see at least 11:37-57). The examiner notes that a "notifying system" is not specifically disclosed in the applicant's specification, and will interpret the portion of the claim as a simple functionality based upon information disclosed in the specification, as opposed to a physical "system";

- e) An update system that updates personal information of the at least one second user of the requesting game machine in said profile server, the personal information comprising the name of the information service being requested (see at least 5:44-6:10, 11:37, and figures 1-4 and 8); and
- f) A transmitter that transmits updated personal information of the second user to the game machine of the first user (see at least figures 10-11 and description thereof).

Regarding claims 2 and 5, Tang describes representations of users that are frequently updated to indicate the activity level of these users, including personal information including the name of the requested information service and the utilization state of the information service by at least one second user selected by the first user in advance, and a display controller that displays the received personal information (see at least abstract, figs. 1-10 and col. 3:32-58).

Regarding claim 3, claim limitations pertaining to “the utilization status comprising at least three states” will be interpreted as a utilization status indicating of one of at least three states. Tang teaches user states within an information service, such as attentive, idle, engaged, do not disturb, and absent, as seen in columns 5 and 6. Tang anticipates the use of a predetermined format to portray information to users (see at least 6:14-26).

Regarding claim 4, Tang anticipates the use of icons (see at least 6:14-26).

Response to Arguments

6. Applicant's arguments filed 5/3/2005 have been fully considered but they are not persuasive.

Applicant contends that the claimed forwarding information from the server that is providing the service is patentably distinguishable from forwarding the information from the device that is requesting the service, as is allegedly done by Tang (Remarks, p.5). Applicant appears to misinterpret the Tang reference such that information is forwarded from the game device requesting the service. However, Tang clearly shows that information is forwarded from the server *in response* to a *request* from a game device (see above).

Applicant alleges that the communications server 80 is software on a client PC and not a physical server. While applicant has not provided any evidence to support this assertion, the server 80 was not mentioned in the previous rejection and is therefore not relevant at this time.

Applicant further argues that Tang does not teach "forwarding status information from the game server to a profile server" (p.6). The arguments are not commensurate in scope with the claimed invention because a game server is not recited by the claims. Therefore, the argument is moot.

Applicant contends that Tang "does not describe how the system would forward information about a service because such a feature is barely mentioned" (p.6).

Applicant appears to acknowledge that the feature is mentioned, if only "barely".

Moreover, the frequency at which a feature is mentioned does not constitute a proper

standard for the propriety of an anticipation rejection, contrary to what is asserted by the applicant. Rather, the fact that a reference discloses a particular feature is what qualifies that reference to serve as anticipatory.

Applicant argues that Tang does not teach the claimed forwarding information from the server providing the service, challenging that the examiner relies upon the chat database and the directory service of Tang without citing the portion of the reference that teaches such. In response, the examiner directs applicant to col. 11:37-65, which details the interactions between the servers regarding data representing users of services such as the directory and chat services. Applicant is also directed to the entirety of col. 11, as well as col. 12.

The argument bridging pages 6-7 of the Remarks explains supposed advantages provided in the claimed invention that are not offered by Tang. However, the supposed advantages are not sufficient to differentiate the claimed invention from that of Tang, nor are the advantages recited by any claim. Therefore the argument is moot.

Finally, applicant alleges that the utilization states showed by the cited references show only two utilization states, on and off. Applicant further alleges that the "more general states of activity" taught by Tang do not pertain to the "specifically claimed utilization status of the information service, which is of course provided by a server" (p. 7). While claim 2 does recite "a utilization state of the information service", there is no claimed limitation that differentiates over the utilization states of the applied references. For example, as was described in the previous action, Tang teaches user

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states within an information service, such as attentive, idle, engaged, do not disturb, and absent, as seen in columns 5 and 6.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

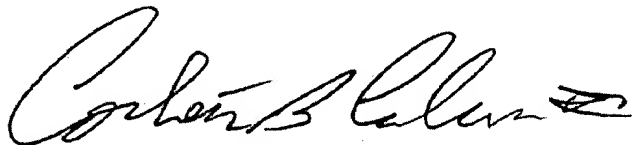
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
12/1/2006


wm



CORBETT B. COBURN
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